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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,088	12/16/2003	Thomas L. Kelly	KES-0003	5181

23413 7590 10/05/2005

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BLOOMFIELD, CT 06002

EXAMINER
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A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

10/737,088

Applicant(s)

KELLY, THOMAS L.

Examiner

Phi D. A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6-7, 9-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (4226071).

Bennett (figure 4) shows a roof system comprising a roof deck (64), an insulation layer (67) supported by the roof deck, an energy absorbing layer (69) supported by the insulation layer, a waterproof membrane (71) loose laid over the energy absorbing layer, the energy absorbing layer being gypsum board, the joints in the insulation layer being offset from joints in the energy absorbing layer, the insulation layer is of a resilient material (polystyrene polymer foam, inherently resilient), the deck is air sealed, the membrane is air sealed to a wall structure (10), the membrane is installed with at least one intentional wrinkle (the overlapping of the roofing felt when bonded together, the overlapping of the felts is inherently capable of functioning as claimed), the at least one wrinkle is located at a perimeter edge of the deck (inherently so as the felt covers substantially the whole deck), the at least one wrinkle is located within a field of the membrane, the at least one wrinkle is located at protrusions (where the felts overlap) of the roof membrane, the at least one wrinkle is located at both a field of the membrane and perimeter edge of the roof deck, the at least one wrinkle is adhered to an underlying layer (49) of the system with an adherent composed to yield to shear force thereon, a wind blown debris resistant roof system comprising a roof deck (64), a layer of stiff material (66) attached to

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the roof deck, a primary waterproofing membrane (67) supported by the stiff material, a roof insulation (68) and energy absorbing layer (69) loose laid over the primary water proofing membrane, a secondary waterproofing membrane (49, 71) disposed over the energy absorbing layer, a preexisting roof assembly that is air sealed underlying at least the energy absorbing layer.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (4226071).

Bennett shows all the claimed limitations except for the gypsum board being ½ inch thick.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bennett's board to show the board being ½ inch thick because it would have been an obvious matter of engineering design choice to have the board being ½ inch since such a modification would have involved a mere change in the size of a component; a change in size is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 USPQ 237 (CCPA 1955).

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (4226071) in view of Nurley et al (6250036)

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Bennett shows all the claimed limitations except for the membrane being fiberglass reinforced, the membrane being about 80 mil fiberglass reinforced or thicker.

Nurley et al ( col 6 lines 28-45) discloses felt heavily reinforced with fiberglass would provide the properties of silencing sound, cushioning effect and deform slightly when forces are applied generally perpendicular to upper and lower surface of the material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bennett's board to show the membrane being fiberglass reinforced, the membrane being about 80 mil fiberglass reinforced or thicker because having the felt being fiberglass reinforced would provide the properties of silencing sound, cushioning effect and deform slightly when forces are applied generally perpendicular to the surface of the material as taught by Nurley et al, and these properties are desired for a roofing membrane, and having the membrane being 80 mil fiberglass reinforced or thicker would have been obvious to one having ordinary skill in the art as it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (4226071).

Bennett shows all the claimed limitations except for the resilient material being about 1.5 inch thick or more

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bennett's board to show the resilient material being about 1.5 inch thick or more because it would have been an obvious matter of engineering design choice to have the

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board being ½ inch since such a modification would have involved a mere change in the size of a component; a change in size is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 USPQ 237 (CCPA 1955).

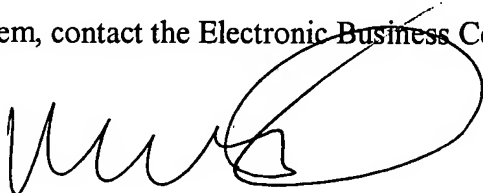
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different roofing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Laina Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

9/30/05